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FILE COPY

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Supreme Court of the United States

OCTOBER TERM, 1940

No. 666

DETROLA RADIO & TELEVISION CORPORATION,

Petitioner,

vs.

HAZELTINE CORPORATION,

Respondent.

BRIEF FOR RESPONDENT IN ANSWER TO PETITIONER'S REPLY BRIEF

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We feel called upon to file this comment on petitioner's reply brief because we are mindful of the result in *Keller v. Adams-Campbell Co.*, 264 U.S. 314, and feel that it is our duty to do what we can to make it clear to the Court at this stage of the proceedings that there is in fact no conflict between the decisions of the Sixth and Second Circuits, rather than have the Court come to that conclusion only after final argument.

There are two matters to which we direct the Court's attention, and both of these, we believe, go to the heart of the petition.

1. The first of these is that petitioner has not disputed our factual analysis of the decisions in the Sixth and Sec-

ond Circuits—petitioner does not dispute that the Sixth Circuit Court of Appeals passed on the question whether the very limited claims of the reissue patent 19,744, characterized by a diode and a high external resistance, constituted an invention, whereas the Second Circuit Court of Appeals did not pass on this but passed on the question whether relatively basic claims of the original patent 1,879,863, not limited to the diode and high resistance, constituted an invention.

There being no dispute that the questions ruled on are different, it seems to us clear that there is no conflict and that the petition is unfounded in fact.

2. The second is that petitioner attempts to create the appearance of a conflict (I) by quoting, apart from their context, phrases taken from the opinion of the Second Circuit Court of Appeals, and (II) by discussing "the most refined details of the case". It is on this point that we think our present brief may be helpful.

(I) Petitioner quotes phrases from the opinion of the Second Circuit Court of Appeals to make it appear that the decision went beyond the validity of original claims 1, 5, 6 and 10 to hold that nowhere in the Wheeler specification was there any invention that could be claimed by a proper claim. Although it is on such an assumed ruling that petitioner's assertion of conflict finally rests, petitioner advances no factual support for it. It merely quotes from the opinion of the Second Circuit Court of Appeals phrases such as "if there were a genuine invention to be saved in that way" without explaining that in the context "in that way" meant by limiting the claims in certain ways other than the way they are limited by the reissue patent which was before the Sixth Circuit Court of Appeals. A reading of the opinion of the Second Circuit Court of Appeals makes it clear that in all of petitioner's quotations, the Court is referring to "the invention" and

"Wheeler" and "the steps from them to Wheeler" and "the change" and "the steps he took" and "this patent" as meaning the relatively basic system of claims 1, 5, 6 and 10 with only the three limitations stated in its opinion, and discussed at page 10 of our brief in opposition to the petition, namely (1) to a receiver (79 F. (2d) p. 330, col. 1), (2) to a time delay circuit (p. 331, col. 1), and (3) to a backward feed (p. 330, col. 1) and at no point did the Court of Appeals for the Second Circuit rule on the restricted character of the Wheeler system on which the reissue patent and the opinion of the Sixth Circuit Court of Appeals are founded, namely the diode with a high external resistance. These general, and quite appropriate phrases, which were used by the Second Circuit Court of Appeals in discussing the question before it, namely the validity of the relatively basic original claims 1, 5, 6 and 10, do not, of course, convert the opinion into a ruling on the inventive character of the restricted combination of the reissue patent, yet it is on this that petitioner fundamentally predicates its assertion of conflict.

As we pointed out in our main brief page 11, there have been cases where a court has ruled on the entire disclosure of a patent and has held that there was no invention disclosed, but the present case is not one of them. The present case is one where an inventor disclosed in his original patent application an improved device and inadvertently claimed more than he had a right to claim as new, and then surrendered his patent and secured a reissue to eliminate the excessively broad claims, and this was the view taken by the Sixth Circuit Court of Appeals.

Petitioner would have this Court think otherwise and, to that end, seizes upon phrases taken from the Sixth Circuit opinion apart from their context. But consideration of the Sixth Circuit opinion as a whole makes it apparent that the implications attached by petitioner to isolated phrases are not justified, and that the Sixth Circuit Court of Appeals understood that the instant case is one

where the decision on the original patent did not go beyond the relatively broad subject matter of the original claims there litigated, and did not purport to decide that there was no invention disclosed in the original Wheeler patent specification. This is clearly apparent from the reference in the opinion of the Sixth Circuit Court of Appeals to the *Penn Electric* case (R. 1472-3) and from the fact that the court based its decision on the *Van Kannel** case which was a case where the original claims had been held invalid because they claimed more than the patentee had a right to claim as new, saying (R. 1474):

> "This case is squarely controlling here. Wheeler introduced no new matter, and the application for reissue showed that the claims as originally drafted were not commensurate with the invention. The fact that the original patent was held invalid does not defeat the reissue patent."

It is clear that the Court of Appeals for the Sixth Circuit regarded the decision of the Second Circuit as being (as indeed it was) a decision holding that the original Wheeler claims were too broad and not a holding that the original Wheeler patent disclosed no invention.

(II) Although petitioner tries to help create the appearance of conflict by discussing "the most refined details of the case", it must, we think, be apparent that no appearance of conflict on "details" can create any conflict on the actual issues which were decided. But even on these details petitioner is not factually correct.

For example, take the first of these details—Petitioner says (p. 4) "the Sixth Circuit Court of Appeals found the Affel and Heising patents of the prior art to be insufficient to invalidate everything disclosed by the Wheeler

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*VanKannel Revolving Door Co. v. Winton Hotel Co., 276 Fed. 234.

patent." The fact is that in reaching its conclusion that the particular combination claimed in the reissued claims with its diode in series with a high resistance was not anticipated, the court put aside the Affel and Heising patents for reasons briefly stated and proceeded to the Evans patents which, as the experts for both plaintiff and defendant agreed, were the closest disclosure to this subject matter (R. 1480). Petitioner attempts to contrast this with the Second Circuit by saying that the Second Circuit Court of Appeals "found them sufficient for that purpose" although the fact is that the Second Circuit Court of Appeals did not consider everything disclosed in the Wheeler patent and did not consider the relationship of Affel and Heising to the specific combination including the diode in series with a high resistance but only their relationship to claims, 1, 5, 6 and 10, which were before it.

Respectfully submitted,

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January 28, 1941